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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,441	02/19/2004	George Zampetti	SYMM1210-2	5641
38396	7590	07/26/2004	EXAMINER	
JOHN BRUCKNER, P.C. 5708 BACK BAY LANE AUSTIN, TX 78739			NGUYEN, MINH T	
			ART UNIT	PAPER NUMBER
			2816	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/782,441	ZAMPETTI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Minh Nguyen	2816	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,15 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,15 and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/19/04</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: this application is a continuation of US Patent No. 6,765,424, this information should be provided, i.e., insert -- , now US Patent No. 6,765,424 -- to the Cross Reference section in the specification.

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,765,424. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 6 and 15 of the present invention are broader than the scope covered in claim 1 of the U.S. Patent No. 6,765,424.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 27, the claim is indefinite because the dependency status is ambiguous. If the claim is seen as an independent claim, the format for writing causes confusion in determining fee payment (the evidence is that the applicant is paying depended claim fee). If the claim is the dependent claim, it is rejected under 112 4th paragraph for failing to further limit claim 1.

As per claims 28-30, these claims are rejected for the same reason noted in claim 7.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

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international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 15 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,078,595, issued to Jones et al.

As per claim 1, Jones discloses a method (Figs. 1 and 6), comprising:  
receiving a pair of input clock signals (SYSCLK1 and SYSCLK2);  
utilizing a stratum clock state machine (STR3 in clock module 16) to control a multiplexer (the selector which selects either TM12a or TM12b as a primary clock);  
utilizing the MUX the select a main clock (column 4, lines 13-15, i.e., either TM12a or TM12b is selected as a primary);  
inducing a phase build-out activity (STR3 is used to eliminate jitters, column 6, lines 15-20, also see Fig. 5); and  
transmitting the output clock signal (the selected clock signal is transmitted).

As per claim 2, the recited limitation is discussed in claim 1 (one of the phase build-out activities: STR3 is used to eliminate jitters, column 6, lines 15-20, also see Fig. 5) .

As per claim 3, Fig. 1, STR3 in module 16 manages PLLs 26 in TM 12a and TM12b.

As per claims 4-6, column 5, lines 30-40, i.e., stratum STR3 in unit 16 “performs the functions of stratum 3 holdover, free-run clock, and timing synchronization ...”.

As per claim 15, rejected for the same reason noted in claims 4-6.

As per claims 27-30, using a computer program, an apparatus, a field programmable gate array or an application specific integrated circuit for performing the method recited in claim 1 are seen as intended uses for performing the method recited in claim 1, therefore, no patentability

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is given. The evidence is that no structure of any of the recited apparatus or computer program recited in the claims.

5. Claims 1-6, 15 and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,341,149, issued to Bertacchini et al.

As per claim 1, Bertacchini discloses a method (Fig. 2), comprising:

receiving a pair of input clock signals (CLOCK 1, CLOCK2);

utilizing a stratum clock state machine (42, state machine 42 is used to control stratum clocks, see abstract) to control a multiplexer and switching the main clock MASTER CLOCK between the pair of input clock signals (the combination of tristate drivers/receivers 38 of the circuits 24 and 26, column 4, lines 16-18, i.e., either SOURCE1 or SOURCE2 is selected as MASTER CLOCK by the selecting signals ALIGN1 and ALIGN2; in other words, the stratum clock state machine 42 controls the tristate drivers/receivers 38 functioned as multiplexer to select and output either SOURCE 1 or SOURCE2 clock as MASTER CLOCK);

inducing a phase build-out activity (performing the activity jitter eliminations, column 2, lines 1-18); and

transmitting the output clock signal (the MASTER CLOCK signal outs to the other circuits).

As per claim 2, see column 2, lines 1-18, i.e., eliminates the jitter problems.

As per claim 3, the signals SOURCE1 and SOURCE2 of PLLs 12 and 16 are managed by the stratum state machine 42.

As per claims 4-6, stratum 3 of the state machine 42 performs the recited functions which are "normal, freerun and holdover".

As per claim 15, rejected for the same reason noted in claim 4-6.

As per claims 27-30, using a computer program, an apparatus, a field programmable gate array or an application specific integrated circuit for performing the method recited in claim 1 are seen as intended uses for performing the method recited in claim 1, therefore, no patentability is given. The evidence is that no structure of any of the recited apparatus or computer program recited in the claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Nguyen whose telephone number is **571-272-1748**. The examiner can normally be reached on Monday, Tuesday, Thursday, Friday 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Callahan can be reached on 571-272-1740. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



7/22/04

Minh Nguyen  
Primary Examiner  
Art Unit 2816